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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 1, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since the terms "or" and "may" as recited in lines 3 and 11, in said claim, respectively, are vague and not a positive recitation. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 - 5, 7 - 14 and 18 - 38, are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent No. 1,224,535 to Ryder (cited by Applicant) in view of LiVolsi U. S. Patent '556.

Ryder discloses the general combination claimed of a bundling device for handling or storing one or more items comprising a pair of generally rigid jaw members having a hinge end and outer end, wherein, each of said jaw member having an inner retaining surface and an outer press surface extending between the ends of said jaw member, wherein, said jaw members are connected together at their hinge ends defining an open position in which the outer ends are spaced apart and the inner surfaces thereof are generally not facing one another and a second self aligning closed position occurred by merely applying pressure upon the outer press surfaces of said jaw members ; see Figures 1,2,4,6 and the entire document, except that the closed position is defined by a plurality of closed positions . LiVolsi teaches the use of a similar bundling device comprising an adjustable closed position defined by a plurality of closed positions in combination with a pivoted pawl member having a plurality with teeth defining plurality of closed positions for said device ; see Figures 1 - 3, 6, 9 - 12 and the entire document . It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closing position in

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Ryder by merely providing it with an adjustable pawl member along with a plurality of teeth formed therewith in the manner taught, disclosed and suggested by LiVolsi, especially, since such modification involves only routine skill in the art, and/or by merely providing the bundling device in LiVolsi with a hinge means assembly in the manner taught and suggested by Ryder . As to the method as recited in claims 23 - 38, it would obviously and inherently be within the scope of the references as applied . Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice . See In Re Leshin, 125 USPQ 416 . Moreover, the particular shape, location and/or the arrangement selected of an element is considered no more than an obvious matter of design choice .

Claim 6, is rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claim 1, above, and further in view of Blanchard U. S. Patent '248 who teaches the use of a jaw member having an indicia surface and a label means applied to said indicia surface . See Figures 1 - 3, and the entire document and to provide the jaw member in Ryder with an indicia surface in order to apply thereto a label means in the manner taught and suggested by Blanchard, it would have been obvious to one having ordinary skill in the art at the time the invention was made, especially, since such structure is conventional and well known within the art

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Claims 15 - 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claim 1, above, and further in view of Stehlin U. S. Patent '095 who teaches the use of a hinge mechanism formed at one end of jaw members including a mating teeth defining abutting frictional surfaces on said jaw members ; see Figures 1, 4, column 3, lines 21 - 34 and the entire document and to further provide the jaw members in Ryder with a hinge - type mechanism including mating teeth in the manner taught and suggested by Stehlin, it would have been obvious to one having ordinary skill in the art at the time the invention was made .

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 23 - 38, are further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20, of U.S. Patent No. 5,729,872.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the omission of an element from a prior-art structure and also its function is not such a change as constitutes invention. See *In Re Trester* 391 OG 501.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the prior art cited herein, and of record, but not applied, as showing structure related to Applicant's disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Victor Sakran** whose **telephone number is (703) 308-2224**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (703) 308-3179. The **fax phone number for this Group is (703) 305-3597 or 305-3598**.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


VICTOR SAKRAN
PRIMARY EXAMINER
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November 22, 1999